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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/714,637	11/16/2000	Kouichi Matsuda	203828US6	5346

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EXAMINER	
NGUYEN, CAO H	

ART UNIT	PAPER NUMBER
2173	

DATE MAILED: 11/10/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)
	09/714,637	MATSUDA, KOUICHI
	Examiner	Art Unit
	Cao (Kevin) Nguyen	2173

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *07 April 2004*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-18 and 20-21* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-18 and 20-21* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

2. Claims 1-18 and 20-21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Viktorsson et al. (US Patent No. 6,397,080) in view of Schmidt et al. (US Patent No. 6,484,037).

Regarding claim 1, Viktorsson discloses a conversation support system for supporting a plurality of users in having a virtual conversation in a shared virtual space built and provided on a computer network, comprising: enrolling means for enrolling an avatar of a logged-in user into said shared virtual space (see abstract); imparting means for imparting a virtual mobile telephone to each avatar in said shared virtual space, said virtual mobile telephone being usable within said shared virtual space (see col. 3, lines 4-34); however, Viktorsson fails to explicitly teach determination means for determining, in response to a call to a virtual mobile telephone, whether a calling party who originated said call exists from a telephone in said shared virtual space, (2) from a telephone in another virtual space, or (3) from a telephone in the real world, and connecting means for executing connection processing in accordance with the determination made by said determination means.

Schmidt teaches determination means for determining, in response to a call to a virtual mobile telephone, whether a calling party who originated said call exists from a

telephone in said shared virtual space, (2) from a telephone in another virtual space, or (3) from a telephone in the real world, and connecting means for executing connection processing in accordance with the determination made by said determination means (see col. 10, lines 1-31). It would have been obvious to one of an ordinary skill in the art at the time the invention was made to provide in response to a call to a virtual mobile telephone, whether a calling party who originated said call exists from a telephone in said shared virtual space, (2) from a telephone in another virtual space, or (3) from a telephone in the real world, and connecting means for executing connection processing in accordance with the determination made by said determination means as taught by Schmidt used in combination of Viktorsson to provide a virtual environment users, which have entered the virtual world, can communicate with other users by means of an avatar.

Regarding claim 2, Schmidt discloses the conversation support system according to claim 1, wherein, if the determination means determines that said calling party originated said call from said telephone in the real world, said connecting means establishes a connection with said calling party through a public telephone network in the real world or executes message transfer (see col. 7, lines 1-52).

Regarding claim 3, Viktorsson discloses the conversation support system according to claim 1, wherein, if the determination means determines that said calling party originated said call from said telephone in said another virtual space, said connecting means establishes a connection with said telephone in said another virtual space or executes message transfer (see col. 3, lines 35-61 and col. 4, lines 1-9).

Regarding claim 4, Viktorsson discloses the conversation support system according to claim 1, wherein said connecting means receives said call from said

telephone in the real world or a virtual telephone in said another virtual space and connects the received call to a virtual mobile telephone of a called avatar in said shared virtual space (see figures 1-2).

As claims 5-14 are analyzed as previously discussed with respected to claims 1-4 above.

Regarding claims 15-17, Viktorsson discloses a conversation support method for supporting an activity of an avatar in a shared virtual space built and provided on a computer network, comprising: receiving a request for sending a message from said avatar; determining whether a destination of said message exists in the real world; and executing connection processing in accordance with the determination made by the determining step (see figures 1-2).

As claims 18-21 are analyzed as previously discussed with respected to claims 1-4 and 15 above.

Response to Arguments

3. Applicant's arguments filed 04/07/04 have been fully considered but they are not persuasive.

On page 10 of the remarks; applicant argues that the combination of Viktorsson and Schmidt do not teach or suggest "imparting a virtual mobile telephone to each avatar in said shared virtual space"; however, the limitations as claimed set forth to read on "The service list (EF-SST) is extended with a service for avatar identity. In combination with the security facility of the GSM system, the network may ask the MS for the subscribers trusted avatar identity representation. There may be several types of avatar representations for different use stored on the SIM card. One application may be

what can be referred to as "A-face" presentation. This is the same functionality as A-number presentation in the original, conventional, telecommunication network, but in this case a simple iconic representation of the calling subscriber is transferred during call-up to the B subscriber to be presented before the called mobile station picks up the call. It is also possible to use the avatar feature made available by means of including it in the SIM-card to enter with an avatar into a virtual world using a 3d representation stored in a EF-A3D file on the SIM. This is done by the network asking the MS for this specific type of representation after the communication has been established with the virtual world." See Viktorsson col. 3, lines 4-25.

In response to applicant's argument on pages 11, third paragraph that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 19880; *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, Viktorsson discloses imparting a virtual mobile telephone to each avatar in said shared virtual space used in combination of Schmidt teaches determination means for determining, in response to a call to a virtual mobile telephone. One skill in the art would have been obvious to provide a virtual environment users, which have entered the virtual world, can communicate with other users by means of an avatar.

On page 13 of the remarks; applicant argues that the combination of Viktorsson and Schmidt do not teach or suggest "exists in the real world"; however, the limitations

as claimed set forth to read on the system is supplemented with a "talking head" representation, which may be defined in an file on the SIM. This representation is used by the network or other MS units in the network to modulate the avatar representation synchronously with the subscriber's speech, e.g. moving the lips and face of an avatar presentation synchronously with the speech. Different services in the network may ask for avatar representations, such as downloading avatars or the talking heads model for personalizing an agent for e.g. animated avatar enhanced voice mailbox messages. Thus, by storing avatar information on a removable memory card, such as on a SIM card, Smart card or the like, the information about the avatar can be moved around and used in many different equipment. The avatar card can for example be used for accessing a virtual world from a mobile phone, a public phone booth, a public internet terminal, a personal computer (PC) or any other communication that can read the card comprising the avatar information. The use of such an avatar card in the form of a SIM card a Smart card etc. will facilitate the introduction and the use of new telecommunication services using avatars; see Viktorsson col. 3, lines 35-57.

Accordingly, the claimed invention as represented in the claims does not represent a patentable distinction over the art of record.

Conclusion

4. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. (see PTO-892).

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Cao (Kevin) Nguyen whose telephone number is (571)272-4053. The examiner can normally be reached on 8:30AM-5:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Cabeca can be reached on (571)272-4048. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Cao (Kevin) Nguyen
Primary Examiner